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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ANDREW ROUSE, QUINTON ZONDERVAN,
THOMAS BENTLEY, TIMOTHY LAWSON, and
CHRISTOPHER HEROT

Appeal 2010-011595
Application 09/750,320
Technology Center 2600

Before THOMAS S. HAHN, DENISE M. POTHIER, and
JENNIFER S. BISK, *Administrative Patent Judges*.

HAHN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants invoke our review under 35 U.S.C. § 134(a) from final rejections of claims 21, 22, 24-30, 32-35, 37-39, and 41-44. Claims 1-20, 23, 31, 36, and 40 are canceled (App. Br. 2).¹ We have jurisdiction under 35 U.S.C. § 6(b).

¹ Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Final Action (mailed Sept. 8, 2008), the Supplemental Appeal Brief (filed Jan. 11, 2010), the Examiner's Answer (mailed Apr. 15, 2010 (Ans.)), and the Reply Brief (Filed June 15, 2010 (Reply Br.)).

We affirm-in-part, and enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

STATEMENT OF CASE

Introduction

Appellants' claim a system and method for enabling a mobile device user to access server-based information over a wireless data network (*see generally* Abstract). The below reproduced claim 21, with disputed limitations emphasized, is exemplary of the appealed independent claims:

21. A method for enabling a wireless client device to communicate with at least one server having one or more applications residing thereon, the method comprising the steps of:

enabling the wireless client device to select an application residing on the at least one server;

enabling the wireless client device to select at least one application action associated with the selected application residing on the at least one server;

executing the at least one selected application action on the at least one server, the application action comprising one or more of opening at least one file within the server, closing at least one file within the server, editing at least one file within the server, or searching at least one file within the server;

formatting at least one application output associated with the at least one selected application actions based on a profile of the

wireless client device and a user selection of one or more fields associated with the at least one file; and

transmitting the formatted at least one application output to the wireless client device.

Rejections

The Examiner relies upon the following prior art:²

Ulrich	US 6,052,735	Apr. 18, 2000
Criss	US 6,308,061 B1	Oct. 23, 2001
Kobayashi	US 6,633,759 B1	Oct. 14, 2003

The Examiner, under 35 U.S.C. § 103(a), rejected:

1. Claims 21, 22, 25-30, 32-35, 37-39, and 42-44 as obvious over Kobayashi and Ulrich (Final Action 3-6); and
2. Claims 24 and 41 as obvious over Kobayashi, Ulrich, and Criss (Final Action 7).

Appellants' Pivotal Contentions

Appellants group independent claims 21 and 38 and assert their patentability is premised on arguments directed to the above identified claim 21 disputed limitations (App. Br. 7-12; Reply Br. 4-7), which also are recited in independent claim 38. Appellants particularly contend the Examiner erred in the rejection because (i) Kobayashi and Ulrich, alone or in combination, are asserted to fail to teach or suggest the disputed limitations

² Effective filing dates for cited prior art precede Appellants' earliest effective filing date and are not at issue.

(App. Br. 8-10; Reply Br. 4-6); and (ii) the Examiner failed “to provide evidence establishing that it would have been obvious to one of ordinary skill in the art to combine the teachings of Kobayashi and Ulrich in the manner proposed” (App. Br. 8).

Appellants group dependent claims 24 and 41 and assert their patentability is premised on arguments directed to their identically recited limitations (App. Br. 14-15; Reply Br. 7-8), namely “the profile of the wireless client device comprises one or both of at least one feature of the wireless client device or a device type of the wireless client device.” Pivotaly, Appellants contend the Examiner erred because Kobayashi, Ulrich, and Criss, alone or in combination fail to teach or suggest the above limitations (App. Br. 14-15).

ANALYSIS

OBVIOUSNESS OVER KOBAYASHI AND ULRICH

A. Claims 21 and 38 and their dependent claims

The Examiner addresses the disputed limitations, in the Response to Argument section of the Answer, with references to reproductions of selected Kobayashi disclosures along with an associated Fig. 9 (Ans. 8-9). The Examiner finds these disclosures and drawing teach (i) “a communication system that allows [a] mobile communication device to access application[s] or software on [a] server/computer by at least starting/opening the software, such as e-mail or word process file[s];” and (ii) “formatting at least one application output associated with at least one

selected application[]” (Ans. 9). Appellants acknowledge the Examiner’s findings and do not dispute them (Reply Br. 4-5). Based on our review of the record, we agree with and adopt these findings from Kobayashi.

The Examiner next acknowledges that “Kobayashi does not teach that . . . formatting is based on a profile of the mobile device and a user selection of one or more fields associated with the at least one file” (Ans. 9). The Examiner finds from the reproduced Ulrich’s disclosures directed to a user setting “profile parameters” (Ans. 9-10) that Ulrich teaches a system to allow a “user [to] remotely at least open [a] file on [a] server/computer and transfer any data according to the user selected profile and format the data such that it can be understood by [a] mobile device when the mobile device[] receives it (see figure[s] 5A and 6)” (Ans. 10). Based on our review of the record, we agree with and adopt these findings from Ulrich.

Appellants acknowledge that both Kobayashi and Ulrich teach formatting, but contend that the references teach formatting for different purposes (Reply Br. 6). Appellants contend Kobayashi’s disclosures are directed to “alteration of visual content generated on a laptop to permit display on a cellular telephone,” and Ulrich’s disclosures are directed to “conversion of files so that they can be manipulated locally on the cellular telephone” (*id.*). Appellants argue that:

Even if the conversion of electronic files described in the cited sections of Ulrich is made . . . “based on a profile of the mobile device and a user selection of one or more fields associated with the at least

one file”, it would not have been obvious to one of ordinary skill in the art to modify the cited sections of Kobayashi in performing a completely different kind of operation (the alteration of visual content).

(*Id.*).

What the Examiner has articulated as a reason for combining the references is that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to combine [Kobayashi and Ulrich] to properly forward attachment[s] to the destination with compatibility” (Ans. 4). In the Response to Argument section of the Answer, the Examiner further articulates that “[i]t would have been obvious to one of ordinary skill in the art to combine the teaching of Ulrich with Kobayashi’s system so that the received data would be compatible with the mobile device and viewable by the user . . .” (Ans. 10). We conclude that these articulations, in view of the record, adequately present reasoning with a rational underpinning for why an ordinarily skilled artisan would appreciate that combining Kobayashi and Ulrich provides a predictable benefit, i.e., a capability for effectively transferring compatible formatted data to a mobile device so that it also is viewable by a user. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”). The record relied on for our concluding

the Examiner adequately articulated reasoning with rational underpinning include the above addressed citations to Kobayashi and Ulrich disclosures that provide verifying evidence for the identified teachings (*see* Ans. 9-10), which specify conforming data to accomplish effective transfer for viewing and use on a receiving mobile device.

In concordance with this record and relevant to our concluding the Examiner did not err in rejecting claims 21 and 38 is the Supreme Court's holding that "[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 420 (2007). The Court further has held that obviousness "analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418.

Accordingly, Appellants' arguments are found unavailing as to the Examiner erring in combining references and concluding the combined references teach or suggest the disputed limitations. In part, we find the arguments unavailing because no persuasive evidence is found that identifies (i) an unpredictable result from the combined references or (ii) a result as being beyond the creative steps that an ordinarily skilled artisan would employ. Consequently, we will sustain the rejection of claims 21 and 38.

We also will sustain the rejection of their dependent claims 22, 26, 39, and 43 that are not separately argued.

Claims 24 and 41 are not listed for this rejection or addressed in the statement of reasons (*see* Ans. 3-6). However, claims 25, 27, 42, and 44, which respectively depend from claims 24 and 41 are listed and addressed in the statement of reasons for this rejection (*id.*). Claims 25, 27, 42, and 44, because of their dependencies, respectively by reference incorporate the limitations of claims 24 and 41. 35 U.S.C. § 112, fourth paragraph. The consequence of the Examiner's rejection of claims 25, 27, 42, and 44 and silence as to the incorporated limitations of claims 24 and 41 is that the rejection fails to establish a *prima facie* case of obviousness.³ Appellants, therefore, have no burden to traverse the Examiner's reported rejection of claims 25, 27, 42, and 44. Accordingly, we *pro forma* reverse the Examiner's reported rejection of claims 25, 27, 42, and 44.

Claims 28 and 33 and their dependent claims

Appellants group independent claims 28 and 33 and assert their patentability is premised on arguments directed to identified limitations (App. Br. 13), which are substantively recited in both claims (App. Br. 12-

³ The Examiner has the initial burden to set forth the bases for all rejections so as to put an Applicant on notice of the reasons why the scope of each rejected claim is not patentable – the so called “*prima facie* case.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (the initial burden is on the Examiner “to produce the factual basis for its rejection of an application under sections 102 and 103”) (quoting *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)).

14). Appellants particularly contend the Examiner erred in the rejection because Kobayashi and Ulrich, alone or in combination, fail to teach or suggest the identified limitations (App. Br. 13-14), and because the Examiner failed “to provide evidence establishing that it would have been obvious to one of ordinary skill in the art to combine the teachings of Kobayashi and Ulrich in the manner proposed” (App. Br. 13).

The identified limitations for claims 28 and 33, as well as Appellants’ contentions and arguments directed to these limitations, are substantively similar to those addressed *supra* for claims 21 and 38. Accordingly, for the reasons discussed *supra*, we will sustain the rejection of independent claims 28 and 33, and we also will sustain the rejection of their dependent claims 29, 30, 32, 34, 35, and 37 that are not separately argued.

OBVIOUSNESS OVER KOBAYASHI, ULRICH, AND CRISS

The Examiner acknowledges that Kobayashi does not teach or suggest limitations recited in dependent claims 24 and 41 (Ans. 7), namely “the profile of the wireless client device comprises one or both of at least one feature of the wireless client device or a device type of the wireless client device.” The Examiner does not address whether Ulrich teaches or suggests these limitations. Despite the Examiner’s silence, as noted *supra* for the rejection over Kobayashi and Ulrich, both the Examiner and we find Ulrich teaches a user setting “profile parameters” so as to allow the “user [to] remotely at least open [a] file on [a] server/computer and transfer any data

according to the user selected profile and format the data such that it can be understood by [a] mobile device when the mobile device[] receives it (see figure[s] 5A and 6)” (Ans. 10).

Nonetheless, the Examiner for this particular rejection additionally turns to Criss and identifies finding the subject limitations as being taught in this reference (Ans. 7, 10-11), which Appellants dispute (App. Br. 14-15; Reply Br. 7-8). In response, the Examiner identifies that “Criss teaches that packet information comprising [a] Version ID of software, memory, and mode is sent to the server see figure 5a . . .” (Ans. 10). The Examiner further identifies that “[t]his packet information is same as the feature of the mobile device in which [sic] provides to the server such that the server understands the capacity of the mobile device before the server transfer[s] data information to the mobile device for upgrade” (Ans. 11).

Appellants respond with pivotal contentions that:

FIG. 5A of Criss provides an illustration of package definition files stored in a host computer that represent features of the software that is to be installed on the mobile device, not features of the mobile devices [c. 10, ll. 1-54]. In particular, the supposed “capacity” in the package definition file relied on in the Answer appears to refer to “an indication of the total memory occupied by the operating software associated with the package name” [c. 10, ll.20-23]. Again, this is a feature of the software, and not a feature of a mobile device.

(Reply Br. 7.)

On reviewing the record, and in particular the Appellants’ cited Criss’ disclosures, we find Criss teaches stored software definition files (*see also*

col. 4, lines 51-57); we do not find Criss teaches or suggests wireless client device's profile features as the Examiner contends. For the foregoing reasons, we will not sustain the rejection of claims 24 and 41 as being obvious over Kobayashi, Ulrich and Criss.

In accord with the discussion *supra* concerning claims 25, 27, 42, and 44 being respectively dependent from claims 24 and 41, we also conclude the Examiner erred in not listing claims 25, 27, 42, and 44 with this rejection and identifying them with the articulated findings and reasoning directed to claims 24 and 41. Accordingly, we *pro forma* do not sustain rejection of claims 25, 27, 42, and 44 as being obvious over Kobayashi, Ulrich, and Criss.

NEW GROUND OF REJECTION

Using the authority under 37 C.F.R. § 41.50(b), claims 24, 25, 27, 41, 42, and 44 are rejected under 35 U.S.C. § 103(a) as being obvious over the combination Kobayashi and Ulrich.

In making this rejection we incorporate by reference our above discussions and conclusion sustaining the obviousness rejection of independent base claims 21 and 38 from which claims 24, 25, 27, 41, 42, and 44 respectively depend.

The limitations of both claims 24 and 41 cover a “profile of the wireless client device compris[ing] one or both of at least one feature of the wireless client device or a device type of the wireless client device.”

Arguably, what information (e.g., device's feature or device type) the profile contains is non-functional descriptive material that is not given patentable weight. *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *see also Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential). In such case, the cited prior art need teach nothing more than a profile containing data.

Nevertheless, presuming that information the profile contains is given patentable weight, neither the Examiner nor Appellants have identified any meanings for these limitations other than their customary term meanings in light of the Specification, which we find does not distinguish from customary term meanings (Spec. 31:15 – 32:2; *see* App. Br. 6). Accordingly, we apply customary term meanings. As addressed *supra*, we agree with and adopt the Examiner's findings from the reproduced Ulrich's disclosures directed to a user setting "profile parameters" (Ans. 9-10; *see* Ulrich col. 14, ll. 15-19). , Such profile parameters that are understood by a mobile device (*see id.*) teach and suggest the device's profile comprises a feature of the wireless client device. Without this suggestion, the parameters would not be understood by the mobile device.

Additionally and in particular, we agree with and adopt the Examiner's finding that Ulrich teaches a system to allow a "user [to] remotely at least open [a] file on [a] server/computer and transfer any data according to the user selected profile and format the data such that it can be understood by [a] mobile device when the mobile device[] receives it (see

figure[s] 5A and 6)” (Ans. 10). Based on this undisputed record, we conclude Ulrich teaches or suggests, when combined with Kobayashi, the limitations of claims 24 and 41.

With respect to the limitations of claims 25, 27, 42, and 44, we agree with and adopt the undisputed Examiner’s findings and conclusions (Ans. 5, 6).

We conclude the limitations of claims 24, 25, 27, 41, 42, and 44, based on the record, are obvious over Kobayashi and Ulrich.

CONCLUSIONS

1. The Examiner did not err under 35 U.S.C. § 103(a) in the rejection of claims 21, 22, 26, 28-30, 32-35, 37-39, and 43 as being obvious over Kobayashi and Ulrich.
2. The Examiner erred under 35 U.S.C. § 103(a) in the rejection of claims 25, 27, 42, and 44 as being obvious over Kobayashi and Ulrich.
3. The Examiner erred under 35 U.S.C. § 103(a) in the rejection of claims 24, 25, 27, 41, 42, and 44 as being obvious over Kobayashi, Ulrich, and Criss.
4. A new ground of rejection under 37 C.F.R. § 41.50(b) is entered as to claims 24, 25, 27, 41, 42, and 44 being obvious under 35 U.S.C. § 103(a) over Kobayashi and Ulrich.

DECISION

The Examiner's decision rejecting claims 21, 22, 26, 28-30, 32-35, 37-39, and 43 is affirmed. The Examiner's decision rejecting claims 24, 25, 27, 41, 42, and 44 is reversed.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection..., shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART
37 C.F.R. § 41.50(b)

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